

REMARKS

Applicant respectfully requests reconsideration of the above referenced patent application in view of the amendments and remarks set forth herein, and respectfully request that the Examiner withdraw all rejections. Claims 7 and 50 have been amended. No claims have been canceled. No claims have been added. Thus, claims 1-50 are pending.

Claim Objections

The Office Action objects to claims 7 and 50, citing a lack a period at the end of each of the claims. Claims 7 and 50 are amended herein to correct the informalities. Therefore, Applicant respectfully requests that the above objection be withdrawn.

35 U.S.C. §102 Rejections

35 U.S.C. §102(b) Rejection over *Herman*

The Office Action rejects claims 1-13, 16-20, 23-24 and 26-50 under 35 U.S.C. §102(b) as being anticipated by Herman et al., US Pub. No. 2002/0073043 ("*Herman*"). A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference, wherein the identical invention is shown in as complete detail as is contained in the claim. *See* M.P.E.P. §2131. The Office Action alleges that *Herman* discloses, *inter alia*, receiving a request to generate a secure electronic record of a third-party transaction, wherein the received request includes data associated with the third-party transaction. Applicant traverses the above rejection for at least the following reasons.

The above rejected claims include independent claims 1, 24, 35, 40 and 47. Independent claim 1 states in a salient portion (emphasis added):

“...receiving a **request to generate a secure electronic record of a third-party transaction**, wherein the received request includes data associated with the third-party transaction;...”

Each of independent claims 24, 35, 40 and 47 include similar limitations. Applicant respectfully submits that **none** of rejected claims 1-13, 16-20, 23-24 and 26-50 is anticipated by the reference, based at least on *Herman* failing to disclose one or more limitations in each of independent claims 1, 24, 35, 40 and 47. More particularly, *Herman* **fails** to disclose receiving a request to generate a secure electronic record of a third-party transaction, wherein the received request includes data associated with the third-party transaction, as variously recited in the independent claims.

The Office Action alleges that FIG. 18 of *Herman* discloses receiving a request to generate a secure electronic record of a third-party transaction, while element 720 of FIG. 9 is alleged to disclose the received request including data associated with the third-party transaction. However, the Office Action fails to provide an explanation as to the relationship between FIG. 18 and the data fields 720 of FIG. 9. Applicants note that FIG. 18 is concerned with users **not** registered with a trusted service, while FIG. 9 is concerned with **registered** users of a trusted service. The only description of FIG. 18 is in paragraphs [0712]-[0717] of *Herman*, which state (emphasis added):

“[0712] The embodiment of the invention provides **merchant initiated user trusted service registration** (see FIG. 18).

[0713] The customer requests a form from merchant Web site (1200).

[0714] The form is downloaded from merchant Web site to the customer (1210). The form includes a button that the customer can click to request registration with trusted agent service.

[0715] The merchant server sends a request for customer registration to the trusted agent server (1220).

[0716] The trusted agent server registers and notifies the customer (1230).

[0717] The customer completes the form and uploads it to the merchant (1240).”

In other words, FIG. 18 is **merely** directed to a user **registering** with a trusted service at a merchant's behest. By contrast, data field 720 is directed to a user who has **already registered** with a trusted service **posting an object for sale** by the service. Data field 720 of FIG. 9 is described in paragraphs [0116]-[0119], which states (emphasis added):

"[0116] FIG. 9 describes the process in which a **registered Transactor user posts an object that he has created for sale** in accordance with the previous description in FIG. 6. The following description of the steps in this process uses the FIG. 6 reference numerals and step numbers, along with the FIG. 9 reference numerals:

[0117] In step 1 (at 402), a registered Transactor user (e.g., user 35) **decides to post an object that he has created for sale...**

[0119] Steps 1 through 4 above are further illustrated in FIG. 9 by User 35 (identified by code A1A1A1), digital object 700 (e.g., a file containing binary data), transactor package 710 which wraps the object as described herein, and **data fields 720**. Data fields 720 include a product ID field 722..., a seller ID field 724..., an owner ID field 726 for entering an identification code associated with the owner of the object (in this case, A1A1A1), a price field 728..., a maker ID field 730..., a revenue model field 732..., a total available field 734..., and an FTP field 736 indicating the delivery details for the object.

[0120] The user then uploads (step 5, at 410) the packaged object and fields with instructions for the Transactor Server (illustrated at 740) **to create a new product."**

In other words, FIG. 9 is limited to **registered** users posting an object for sale – i.e. **before** any actual transaction. The Office Action **fails** to provide any explanation as to how *Herman* discloses a "request" in FIG. 18 which includes data field 720 from FIG. 9. Applicants submit that *Herman* does **not** support any such data field 720 in a request in FIG. 18, insofar as the former is used by an **unregistered** user to register with a trusted service, and the latter is used by a **registered** user to post an object for sale with the trusted service.

Applicants further note that *Herman* describes a Smart Receipt which is delivered by a Smart Receipt Agent over a secure connection from the merchant to the Trusted Agent Server upon successful completion of a purchase and reflects the details of the transaction. *See* e.g., Abstract, paragraph [0012]. In other words, a Smart Receipt Agent

installed on a merchant's server **creates** a Smart Receipt representing a purchase. *See*, e.g., paragraph [0723]. Assuming *arguendo* that the reference anticipates all other claim limitations, which Applicant does not agree, *Herman* **fails** to disclose receiving a **request to generate** a secure electronic record of a third-party transaction, insofar as it is **one of the third-parties** (i.e. the merchant) which **generates** the Smart Receipt in *Herman*.

For at least the foregoing reasons, *Herman* fails to disclose at least one element in each of independent claims 1, 24, 35, 40 and 47. In depending directly or indirectly from one of these independent claims, each of dependent claims 2-13, 16-20, 23, 26-34, 36-39, 41-46 and 48-50 incorporates at least one limitation not taught by the reference. Therefore, Applicant requests that the above 35 U.S.C. §102(b) rejection of claims 1-13, 16-20, 23-24 and 26-50 based on *Herman* be withdrawn.

35 U.S.C. §103(a) Rejections

35 U.S.C. §103(a) Rejection over *Herman* and *Hrobsky*

The Office Action rejects claims 14-15, 21-22 and 25 under §103(a) as being obvious in light of *Herman* in view of *Hrobsky*, Martin, *Tax filing made easier through the Internet*, March 12, 2003, Czech Radio, <http://radio.cz> ("*Hrobsky*"). In rejecting the above claims, the Office Action relies in part on the previously-discussed 35 U.S.C. §102(b) rejection of claims 1 and 24 based on *Herman* alone. *Hrobsky* is further alleged to disclose transmission to a special authority such as a tax authority. To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *See* M.P.E.P. § 2143.03. Applicant traverses the above rejection for at least the following reasons.

As discussed above, *Herman* fails to anticipate either of claims 1 and 24 under 35 U.S.C. §102(b). At the very least, *Herman* **fails** to disclose receiving a request to generate a secure electronic record of a third-party transaction, wherein the received request includes data associated with the third-party transaction, as variously recited in the independent claims. In presenting a basis for the above 35 U.S.C. §103(a) rejection,

the Office Action **fails** to provide an additional basis for any combination of *Herman* and *Hrobsky* teaching of suggesting the claim limitations which are **not** anticipated by *Herman* alone. *Hrobsky* is not directed to these claim limitations, and **merely** describes downloading tax **forms** from a server, and sending filled-out versions of the tax forms back to the server with an electronic signature. Therefore, Applicant submits that the references fail to teach or suggest the claim limitations previously discussed in reference to the 35 U.S.C. §102(b) rejection.

Accordingly, each of claims 1 and 24 is non-obvious in light of *Herman* and *Hrobsky*. If an independent claim is non-obvious under 35 U.S.C. §103, then any claims depending therefrom are also non-obvious. *See* M.P.E.P. §2143.03. For at least the foregoing reasons, Applicant requests that the above 35 U.S.C. §103(a) rejection of claims 14-15, 21-22 and 25 based on *Herman* and *Hrobsky* be withdrawn.

CONCLUSION

For at least the foregoing reasons, Applicant submits that the objections and rejections have been overcome. Therefore, claims 1-50 are in condition for allowance and such action is earnestly solicited. The Examiner is respectfully requested to contact the undersigned by telephone if such contact would further the examination of the present application. Please charge any shortages and credit any overcharges to our Deposit Account number 02-2666.

Respectfully submitted,
BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN, LLP

Date: 4/23/2007 /Dermot G. Miller/
Dermot G. Miller
Attorney for Applicants
Reg. No. 58,309

12400 Wilshire Boulevard
Seventh Floor
Los Angeles, CA 90025-1026
(503) 439-8778